

REMARKS/ARGUMENTS

These remarks are made in response to the Office Action of March 13, 2006 (Office Action). As this response is timely filed within the three-month shortened statutory period, no fee is believed due. The Office, nonetheless, is expressly authorized to charge any deficiencies or credit any overpayments to Deposit Account No. 50-0951.

As an initial matter, Applicants thank the Examiner for his thorough review of the Application and for noting at page 2 of the Office Action that the previous rejection has been withdrawn pursuant to Applicants' Amendment and Remarks submitted December 20, 2005. In the present Office Action, Claims 1-4 and 10-19 were rejected under 35 U.S.C. § 103(a) as unpatentable over the newly-cited reference, U.S. Patent No. 6,954,736 to Menninger, *et al.* (hereinafter Menninger).

It is noted in the Office Action that Menninger fails to teach or suggest every feature of the invention. It is stated, however, that features lacking in Menninger are commonly known in the art and that it would have been obvious at the time of the invention to combine those with Menninger. Applicants respectfully disagree, but assert more fundamentally that these issues are moot because Applicants' invention predates the March 23, 2001, effective date of Menninger.

Applicants conceived of their invention at least as early as September 26, 2000, and actively pursued its reduction to practice from a date prior to the effective date of Menninger. In support of their assertion, Applicants submit the Declarations attached hereto from three of the four inventors. The fourth inventor, David Shorter, is deceased. The Declarations establish conception and continuing diligence from a time prior to the effective date of Menninger to the filing of the Application.

Along with their Declarations, Applicants also submit herewith a copy of Confidential Invention Disclosure No. BOC8-2000-0076, entitled *Method and Apparatus for Creating and Exposing Order Status Within A Supply Chain* (hereinafter Disclosure). The Disclosure was submitted on August 28, 2000, by Applicants to an intellectual

property (IP) professional employed by the assignee of Applicants' invention, International Business Machines Corporation (IBM). The Disclosure was insubstantially modified on September 26, 2000, by an IBM IP professional. The Disclosure has not been revised subsequent to September 26, 2000.

The Disclosure explicitly describes and illustrates Applicants' invention. The written description and illustration provided in the Disclosure are clear evidence of Applicants' conception of the claimed subject matter at least as early as September 26, 2000.

The Disclosure is an IBM confidential disclosure form. It is a standardized document that, according to established IBM procedures, is used by IBM inventors to document the conception of an invention. Strictly-followed internal procedures established by IBM govern the use of all such confidential disclosure forms. One aspect of IBM's established procedures governing the use of such confidential disclosure forms is that no substantive modifications can be made to a confidential disclosure after it has been submitted to an IBM Attorney/IP Professional.

The written description, drawings, and each of the claims of the Application were prepared based upon the Applicants' attached Disclosure. Moreover, according to IBM's established procedures governing the use of such disclosures, the inventors reviewed the Application prior to its submission to the U.S. Patent and Trademark Office in order to ensure that the claims and written description contained therein were fully supported by the Disclosure.

Applicants exercised due diligence from prior to the effective date of Menninger to the date that the Application was filed. As expressly affirmed in their Declarations, Applicants from at least August 28, 2000, through the filing of the Application on June 29, 2001, worked diligently toward a constructive reduction to practice of the invention, first with IBM's own in-house IP professionals, and then with outside counsel retained by IBM to prepare and file the Application.

Outside counsel prepared the Application consistent with long-established professional practices, according to which cases are prepared on a first-in, first-out basis, even though those particular applications associated with specific bar dates are granted priority within the work queue. Outside counsel followed this professionally-accepted practice in preparing the Application in this case.

Further evidence of Applicants' due diligence is submitted herewith in the form of correspondence between Applicants and outside counsel. The correspondence evince specific activity on specific dates relating to Applicants' pursuit of a constructive reduction to practice from a time prior to the effective date of Menninger. The correspondence includes a letter of October 2, 2000, from an IBM professional to outside counsel instructing outside counsel to prepare a draft application for Applicants' invention. Correspondence also includes a letter of October 11, 2000, from outside counsel confirming receipt of those instructions. An initial draft application prepared by outside counsel was sent to Applicants on April 13, 2001, as evidenced by the facsimile transmission from outside counsel on that date. A revised draft based on Applicants' review and comments of the initial draft was subsequently sent by outside counsel to Applicants on May 23, 2001.

Applicants respectfully submit that it was reasonable for them to rely on outside counsel in preparing the Application, and that outside counsel acted with diligence, notwithstanding the constraints of other work obligations, in preparing the Application. Applicants further respectfully submit that the evidence of specific activity on specific dates clearly evinces Applicants prior conception and diligence in pursuing a reduction to practice from a time prior to the effective date of Menninger.

Applicants respectfully note that the Declarations and Disclosure were not previously submitted because Applicants' date of conception of the invention and diligence in pursuing a reduction to practice were not previously in issue. The issue has been raised now by the introduction of the reference, Menninger, which was not

previously cited. Accordingly, Applicants respectfully assert that their submission of the Declarations and Disclosure, submitted herewith, is timely.

CONCLUSION

Applicants believe that this Application is now in full condition for allowance, which action is respectfully requested. The Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this response, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

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